

Regarding Applicants' IDS filed on May 18, 2000:

Since the Examiner has not initialed a copy of Applicants' May 18, 2000 IDS, even though this IDS was in compliance with the rules then in effect, Applicants are filing a new IDS concurrently with the RCE to request the Examiner's consideration of co-pending application no. 09/369,174, now matured into U.S. Patent No. 6,335,241 and cited as such on the PTO-1449 form.

Applicants request that the Examiner acknowledge consideration of the listed document by initialing the appropriate portion of the PTO-1449, and request a copy be returned to Applicants with the next communication from the Office.

Regarding the rejection of claim 19 under 35 U.S.C. § 112, 1st ¶:

The Examiner rejected claim 19 under 35 U.S.C. § 112, 1st paragraph, as allegedly "containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention" (Final Office Action, p. 2).

Regarding the rejection of claim 19 under 35 U.S.C. § 112, 1st paragraph, Applicants respectfully dispute the Examiner's allegations made on p. 2 of the Final Office Action. Contrary to the Examiner's allegations, Applicants' specification does describe all claimed subject matter in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner alleged "[t]he limitation (a lower electrode having a side and upper surface, wherein a surface area of the side being larger than a surface area of the upper surface) is not supported by the original specification and/or drawings" (Final Office Action, p. 2, emphasis in original). Applicants again dispute this allegation, noting that the contents of the recitation are disclosed in the specification from p. 27, l. 20 to p. 28, l. 4, the recitation is

completely supported by the original specification. Applicants also submit that the Examiner is improperly attempting to limit the scope of Applicants' claim by citing only Fig. 10B on the Continuation Sheet of the July 16, 2003 Advisory Action. Despite etch back of storage node electrode 27, the side surface area can still be larger than the top when accounting for the depth dimension into the page. Furthermore, Applicants point out that elected Embodiment 5 recites, among other things, "In FIGS. 8A and 8B, the portions the same as those shown in FIGS. 1A and 1B are identified by the same reference numerals, and detailed descriptions thereof are omitted" (Applicants' Specification, p. 32, lines 3 – 6). This shows that the same features of Embodiment 1 are incorporated into Figs. 8A and 8B of Embodiment 5.

In light of the above-mentioned exemplary description of an embodiment of the invention contained in the specification, Applicants therefore submit that the Examiner *still has not met* his "initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims." M.P.E.P. § 2163.04.

Finally, Applicants submit that, for the reasons already presented above, all subject matter in "the specification conveys with a reasonable clarity to those skilled in the art that, as of the filing date sought, applicant[s] [were] in possession of the invention as now claimed." M.P.E.P. § 2163. Claim 19 fully complies with the requirements of 35 U.S.C. § 112, 1st paragraph, and Applicants again request withdrawal of the rejection.

Regarding the rejection of claim 19 under 35 U.S.C. § 102(b):

Applicants respectfully traverse the rejection of claim 19 under 35 U.S.C. § 102(b) as anticipated by Kashihara.

In order to properly establish that Kashihara anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found,

either expressly described or under principles of inherency, in that single reference.

Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Regarding the 35 U.S.C. § 102(b) rejection, Kashihara does not teach each and every element of Applicants’ present invention as claimed.

Applicants’ independent claim 19 recites a combination of elements, among them: “a lower electrode formed in contact with the conductive plug and having a side and upper surface, a surface area of the side being larger than a surface area of the upper surface.”

Kashihara is clearly different from Applicants’ independent claim 19. Unlike Applicants’ claimed invention, Kashihara does not disclose at least these elements of Applicant’s claim 19. In contrast, Kashihara teaches a lower electrode layer 1 formed in contact with a barrier metal layer 13 on plug layer 43a. See Kashihara’s Figure 1. Kashihara does not disclose anything about the lower electrode having a side and upper surface, *a surface area of the side being larger than a surface area of the upper surface*. Further, Kashihara teaches a capacitor insulating layer 3 formed on lower electrode layer 1. Kashihara does not disclose anything about the capacitor insulating layer 3 being formed above a top surface of the lower electrode layer 1 *via a* second insulating film different from the capacitor insulating film. Thus, Kashihara does not disclose each and every element of Applicants’ claim 19.

It appears that Applicants’ previous arguments have been dismissed concerning this point, by both omitting an analysis that includes the full recitation of the elements of Applicants’ claim 19, and by alleging that Applicants’ previous arguments were “not convincing because the limitation (a surface area being larger than a surface area of the upper surface) is not support [ed] by the specification and/or drawings” (Final Office Action, p. 3). Applicants note that the Examiner must consider all the elements of Applicants’ claimed invention, in as complete detail

as contained in the claim, and also must consider all elements even when contesting support in Applicants' specification. Applicants have also already established herein that the elements of Applicants' claimed invention do have full support in the specification and drawings, and furthermore have support in the presently elected embodiment. Applicants respectfully remind the Examiner that the M.P.E.P. establishes that "when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. [citations omitted]." "Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum." M.P.E.P. § 2106.

As Applicants have demonstrated herein, since Kashihara does not disclose each and every element of Applicants' independent claim 19, Kashihara does not anticipate Applicants' claimed invention. Applicants submit that the Examiner has not met the essential requirements of anticipation for a 35 U.S.C. § 102(b) rejection. Therefore, the rejection is improper and should be withdrawn.

Moreover, regarding the Examiner's allegation that Kashihara's "capacitor insulating layer (11d) being formed above a top surface of lower electrode (1) via a second insulating film (3) ... different from the capacitor insulating film..." (Final Office Action, p. 3), it appears that the Examiner alleged certain features are inherent in Kashihara because two different insulating films in Kashihara are composed of different materials. Regardless of whether the two films are composed of different materials, Applicants' note that this is still not one film formed *via* another, and therefore not anticipatory of Applicants' claimed "the capacitor insulating film being formed above a top surface of the lower electrode via a second insulating film different

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

from the capacitor insulating film” (claim 19). Applicants respectfully remind the Examiner that:

“[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. *Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.*”

M.P.E.P. § 2131.01(III), (italics added for emphasis), quoting *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). See also M.P.E.P. § 2112.

Applicants submit that the Examiner has not supplied the requisite extrinsic evidence, let alone any evidence in Kashiara, that makes clear that “the capacitor insulating film being formed above a top surface of the lower electrode via a second insulating film” is necessarily present in Kashiara. In addition, Applicants note that “[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient” M.P.E.P. § 2112 (internal citations omitted). The Examiner has not established that any of Applicants’ claimed features are explicitly taught by Kashiara or, as a secondary consideration, that they are inherent in Kashiara, and has not presented any factual basis or technical reasoning to demonstrate as much. It is therefore improper for the Examiner to infer that Applicants’ claimed features, quoted above, necessarily flow from Kashiara.

Since Kashiara does not disclose each and every element of Applicants’ present invention, Kashiara does not anticipate independent claim 19. Therefore, Applicants respectfully submit that claim 19 is patentable over Kashiara.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Regarding dependent claim 20: "Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim and what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were present as one independent claim." M.P.E.P. § 608.01(n)(III).

Therefore, since Applicants have shown above that independent claim 19 is allowable, Applicants submit that dependent claim 20 is also allowable at least by virtue of their dependence from allowable base claim 19.

Thus, since Kashihara does not disclose each and every element of Applicants' independent claim 19, Kashihara does not anticipate Applicants' claimed invention. In addition to Kashihara not anticipating the present invention, Kashihara does not disclose an identical invention, let alone in as complete detail as contained in Applicants' independent claim 19. Accordingly, Applicants submit that the Examiner has not met these essential requirements of anticipation for a proper 35 U.S.C. § 102(b) rejection.

Conclusion:

In making various references to the specification and drawings set forth herein, it is understood that Applicants are in no way intending to limit the scope of the claims to the exemplary embodiments described in the specification and illustrated in the drawings. Rather, Applicants expressly affirm that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

In view of the foregoing remarks, Applicants request the Examiner's reconsideration of the application and submit that the rejections detailed above should be withdrawn. For the reasons articulated herein, Applicants submit that independent claim 19 is allowable, for the reasons already argued above. In addition, dependent claim 20 is also allowable at least by

virtue of its dependence from allowable base claim 19. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

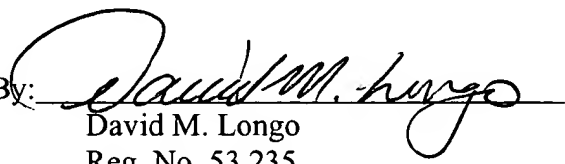
Should the Examiner continue to dispute the patentability of the claims after consideration of this Amendment, Applicants encourage the Examiner to contact Applicants' undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings. Applicants' undersigned representative would welcome the opportunity to discuss the merits of the present invention with the Examiner if telephone communication will aid in advancing prosecution of the present application.

Please grant any extensions of time under 37 C.F.R. § 1.136 required in entering this response. If there are any fees due under 37 C.F.R. § 1.16 or 1.17, which are not enclosed, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 11, 2003

By: 
David M. Longo
Reg. No. 53,235

/direct telephone: (202) 408 - 4489/

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com